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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,553	02/17/2006	Satish Chawdhary	SWIN 3437	4584
7812 7590 01/23/2009 SMITH-HILL AND BEDELL, P.C. 16100 NW CORNELL ROAD, SUITE 220 BEAVERTON, OR 97006				
EXAMINER				
GOSART, TIMOTHY J				
ART UNIT		PAPER NUMBER		
4118				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,553

**Applicant(s)**

CHAWDHARY, SATISH

**Examiner**

TIMOTHY GOSART

**Art Unit**

4118

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 52-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 03/12/2007.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 62, 63, 64, 66, 69, and 71 are objected to because of the following informalities: The language “the cavity” lacks proper antecedent basis. This language is interpreted as “the central cavity.” Appropriate correction is required.
2. Claim 66 is objected to because of the following informalities: The language “the anterior and posterior members” lacks proper antecedent basis. This language is interpreted as “the anterior and posterior walls” for examination purposes. Appropriate correction is required.
3. Claim 71 is objected to because of the following informalities: The language “the cavity” lacks proper antecedent basis. The claims are interpreted such that Claim 71 is dependent on Claim 70 as recited, but that Claim 70 is dependent on Claim 60, where “a central cavity” is first recited, rather than Claim 59. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. Claims 58 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding claims 58 and 74, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 52-69 and 75-81 are rejected under 35 U.S.C. 102(a) as being anticipated by Nun (WO 03015669).
8. Regarding Claim 52, Nun discloses an intraocular device including an optic member 30 and a means for altering the shape of the optic member to alter its focusing power (Figure 4B and Page 10, Line 21 – Page 11, Line 2).
9. Regarding Claims 53-54, the Nun device is configured to be capable of being located in front of the normal lens of the eye and outside of the capsular bag PC (Figure 4B).
10. Regarding Claim 55, the optic member of the Nun device is alterable between a relaxed shape (Figure 4A) and a focusing shape (Figure 4B) which it is capable of providing focusing power in the range of 3 to 6 diopters (Page 10, Line 21 – Page 11, Line 2).
11. Regarding Claim 56, the optic member of the Nun device is convex in the focusing shape (Figure 4B and Page 10, Lines 26-28).
12. Regarding Claim 57, the optic member of the Nun device alters shape in response to ciliary muscle stimulus (Page 10, Line 21 – Page 11, Line 2).

13. Regarding Claim 58, the optic member of the Nun device alters shape to a varying extent as a function of ciliary muscle stimulus magnitude (Page 10, Lines 26-28).
14. Regarding Claims 59-60, the Nun device includes a fluid reservoir 30 in communication with a central cavity 35 (Figure 4B and Page 5, Lines 9-14).
15. Regarding Claims 61-63, the means for altering the shape of the optic member of the Nun device includes fluid moving from the reservoir into or out of the central cavity; the amount of fluid moving being a response proportional to the contraction of the ciliary muscle (Page 10, Line 21 – Page 11, Line 2).
16. Regarding Claim 64, the central cavity of the Nun device is defined by walls 24 and 31 in a position in which the central cavity contains little fluid (Figure 4A) but wherein the walls move into a position in which the central cavity contains fluid (Figure 4B). Fluid moves from the central cavity into the reservoir in response to relaxation of the ciliary muscle (Page 10, Line 21 – Page 11, Line 2).
17. Regarding Claim 65, the walls of the central cavity of the Nun device are anterior and posterior to the central cavity; the anterior wall, defined by the bulge 35 of resilient body 30, being flexible, transparent, and planar in an unstressed condition (Figure 4A and Page 5, Lines 9-10) and the posterior wall, defined by planar edge 31, being rigid, transparent, and planar (Page 10, Line 21 – Page 11, Line 2).
18. Regarding Claim 66, the anterior and posterior walls of the Nun device are adjacent when there is no fluid in the central cavity (Figure 4A).
19. Regarding Claim 67, the anterior wall of the Nun device flexes away from the posterior wall into a convex shape 35 when there is fluid in the reservoir and is capable of returning to an

unstressed, planar condition upon relaxation of the ciliary muscle (Figure 4B and Page 10, Line 21 – Page 11, Line 2).

20. Regarding Claims 68-69, the Nun device includes a conduit or capillary tube, defined by the portion of the resilient body 30 that is lateral to the central cavity 35, which provides fluid connection between the central cavity and the reservoir (Figure 4B).

21. Regarding Claims 75-76, the optic member of the Nun device is capable of being configured for location behind or in front of the iris. For example, depending on the size requirement of lens/piston member 31, haptic members 24 are capable of being implanted in the posterior chamber or anterior chamber of the eye.

22. Regarding Claims 77-79, the Nun device includes an artificial lens 31 positionable on the optic axis and wherein the optic member covers and is fused to a central part of the artificial lens (Figure 4B).

23. Regarding Claims 80-81, the Nun device is capable of being configured for location between the lens and the iris and outside the capsular bag PC and in contact with the ciliary muscle CB to be compressible by the ciliary muscle (Figure 4B and Page 10, Line 21 – Page 11, Line 2).

24. Claims 52, 59, and 70-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Esch (US 7122053).

25. Regarding Claim 52, Esch discloses an intraocular device including an optic member 43 and 45 and a means for altering the shape of the optic member to alter its focusing power (Figure 4B and Column 7, Lines 37-51).

26. Regarding Claim 59, the Esch device includes a fluid reservoir 48 in communication with a central cavity (central chamber) 47 of the optic member (Figure 4B).
27. Regarding Claims 70-71, the reservoir of the Esch device is configured for location adjacent to ciliary muscle such that contraction of the ciliary muscle causes compression of the reservoir and forces fluid into the central cavity (Column 7, Lines 37-51).
28. Regarding Claims 72-74, the Esch device includes two reservoirs 48 to be diametrically opposed, each reservoir comprising an outward elastic material allowing for compression by contraction of the ciliary muscle (Column 6, Lines 56-60) and base member 46 made of a rigid polymer (Column 6, Lines 49-50) such that the outward elastic material and the rigid base member define a chamber for fluid which moves to central cavity 47 via capillary tubes 49 (Figure 4B).

### *Conclusion*

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gross (US 20050251253) discloses an intraocular implant comprising various fluid reservoir and cavity configurations.

Kelman (US 4769035) discloses an intraocular implant configured for anchoring at various locations of the eye.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY GOSART whose telephone number is (571)270-7826. The examiner can normally be reached on Monday-Friday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quang Thanh can be reached on (571)272-4982. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Quang D. Thanh/  
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